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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/811,434 03/03/97 LLI

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EXAMINER

SUBS40Y.1

ART UNIT

PAPER NUMBER

1724

DATE MAILED:

12/11/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/811,434

Applicant(s)

LEE ET AL

Examiner

Scott Bushey

Group Art Unit

1724



☒ Responsive to communication(s) filed on 10-15-98 and 12-1-98

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 35-37 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 35-37 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2 sheets

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 35-37 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention. Applicant has admitted during the personal interview of October 15, 1998 and again in the remarks portion of the amendment filed December 1, 1998, that the instant invention was offered for sale to a public party more than 1 year prior to the filing date of this application. This application names four co-inventors, while parent application S.N. 08/742,819 names only three of the four co-inventors of this application as co-inventors of the parent application. Accordingly, absent a showing that the fourth or additional inventor named as a co-inventor in this application did not actually participate in the invention of the claims 35-37 as presently recited, the effective filing date of this application must be considered as March 3, 1997, not the filing date of the parent application 08/742,819, which was filed on October 20, 1996, or less than 1 year after the offer for sale of the instant invention.

3. Claims 35-37 are provisionally rejected under 35 U.S.C. 102(e) as being anticipated by copending Application No.08/742,819 which has a common inventor with the instant application.

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Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e), if patented. This provisional rejection under 35 U.S.C. 102(e) is based upon a presumption of future patenting of the copending application. Applicant should note that this rejection is made in view of the fact that the subject matter of claims 35-37, as now present in the instant application, finds full support in the disclosure of copending application 08/742,819, but the instant application has a different inventive entity than that of the earlier filed application.

This provisional rejection under 35 U.S.C. 102(e) might be overcome by a showing under 37 CFR 1.130 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another". In other words, applicant should show that Leon Fan, named in the declaration of this application as a co-inventor of the invention of this application, was not in fact a co-inventor of the invention as recited by instant claims 35-37. A proper showing of this type would also preclude any holding of an "on-sale" bar, since such showing would clearly establish an effective filing date of the claims of this application as that of the parent application 08/742,819, the filing date of October 20, 1996 of the parent application which would be less than one year after the offer to place the invention "on-sale" was made.

This 102(e) rejection may not be overcome by the filing of a terminal disclaimer alone. See *In re Bartfeld*, 925 F.2d 1450, 17 USPQ2d 1885 (Fed. Cir. 1991).

4. Applicant should note the following quotation of 37 CFR 1.130 from the MPEP:

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§ 1.130 Affidavit or declaration to disqualify commonly owned patent as prior art.

(a) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 103 in view of a U.S. patent which is not prior art under 35 U.S.C. 102(b), and the inventions defined by the claims in the application or patent under reexamination and by the claims in the patent are not identical but are not patentably distinct, and the inventions are owned by the same party, the applicant or owner of the patent under reexamination may disqualify the patent as prior art. The patent can be disqualified as prior art by submission of:

- (1) A terminal disclaimer in accordance with § 1.321(c), and
- (2) An oath or declaration stating that the application or patent under reexamination and the patent are currently owned by the same party, and that the inventor named in the application or patent under reexamination is the prior inventor under 35 U.S.C. 104.

(b) When an application or a patent under reexamination claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same or a different inventive entity, a double patenting rejection will be made in the application or a patent under reexamination. A judicially created double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(c).

[Added, 61 FR 42790, Aug. 19, 1996, effective Sept. 23, 1996]

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 35-37 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-26 of copending Application No. 08/742,819. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A chemical process tower having at least one tray with an inlet area, and a downcomer having a wall which tapers to an inner wall of the process tower in the area of the inlet region to a lower tray.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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7. Applicant's arguments with respect to claims 35-37 have been considered but are moot in view of the new grounds of rejection.

Applicant should note however, that claims 35-37 are considered to be allowable over the prior art of record, with the exception of copending application S.N. 08/742,819, which has been applied in each of the rejections in paragraphs 3 and 6 above. Further, the pending "on-sale" bar rejection could be overcome by a proper timely filing of the necessary showing as discussed in paragraphs 2 and 3 above.

8. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott Bushey whose telephone number is (703) 308-3581.

C. SCOTT BUSHEY
PRIMARY EXAMINER
GROUP 1300

csb

December 9, 1998


12-9-98